



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|------------------------------|------------------|
| 09/811,129 | 03/16/2001 | Kingsum Chow | 42390P10466 | 6517 |
| 8791 7590 04/16/2007 BLAKELY SOKOLOFF TAYLOR & ZAFMAN 12400 WILSHIRE BOULEVARD SEVENTH FLOOR LOS ANGELES, CA 90025-1030 | | | EXAMINER BLAIR, DOUGLAS B | |
| | | | ART UNIT 2142 | PAPER NUMBER |
| SHORTENED STATUTORY PERIOD OF RESPONSE | | | MAIL DATE | DELIVERY MODE |
| 3 MONTHS | | | 04/16/2007 | PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

| | | | |
|------------------------------|--------------------------------------|------------------------------------|--|
| Office Action Summary | Application No. 09/811,129 | Applicant(s) CHOW ET AL. | |
| | Examiner Douglas B. Blair | Art Unit 2142 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 January 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8, 10-16, 18-25, 27-33, 35-38 and 40-50 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 10-16, 18-25, 27-33, 35-38 and 40-50 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Claims 1-8, 10-16, 18-25, 27-33, 35-38, and 40-50 are now pending. The applicant has cancelled claims 9, 17, 26, 34, and 39 and added claims 44-50.

Specification

2. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: the specification does not describe a “readable medium” as claimed in claims 18, 25, and 31.

Response to Arguments

3. Applicant's arguments filed 1/12/2007 have been fully considered but they are not persuasive.

4. The applicant argues that Merriman does not teach or suggest identifying a construction format for the domain name. The applicant then goes on to point out supposed deficiencies in the Merriman invention. In response to this argument, the Examiner points out that the applicant's claim is broad enough to cover Merriman because the domain name extensions are a “construction format” and a country code is geographically significant. Given the broad nature of the applicant's claims, the supposed deficiencies pointed out by the applicant are irrelevant because the applicant is not claiming anything specific about the “construction format”.

5. The applicant argues that in Ansell, a trace route is only performed in “dire circumstances” and in contrast, the applicant’s claims require a trace route either be performed or utilized in each and every case. In response, the Examiner points out that the trace route is performed in each and every case in dire circumstances, therefore the “dire circumstances” of Ansell read on the applicant’s claimed invention.

6. With respect to Ansell, the applicant further argues that it cannot be assume that Ansell performs the same parsing of a domain name returned by a trace route that is performed for the client network address. In response, Ansell points shows how to parse a domain name for geographically significant information so it can be assumed that this technique is applied to the results of the trace route since the results are also domain names.

7. With respect to Ansell, the applicant further argues that Ansell fails to teach or suggest validating a geographic location of the client using the results of the traceroute. The Examiner disagrees because the cited portion of column 10 states that a trace route is spawned if a location cannot be satisfactorily determined. This is considered validation. The applicant’s specification does not describe validation so the term is interpreted broadly.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an

Art Unit: 2142

international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 1-4, 6-8, 10-13, 18-21, 23-25, 27-30, 35-38, 40 and 44-49 are rejected under 35

U.S.C. 102(b) as being anticipated by U.S. Patent Number 5,948,061 to Merriman et al..

10. As to claim 1, Merriman teaches a method for geographic location determination based at least in part on inspection of a network address of a client, the method comprising: performing a trace route between a server and the address of the client (col. 8, lines 6-30); the trace route identifying at least one domain name in a route between the server and the client identifying a construction format for the domain name (col. 4, line 56-col. 5, line 7); identifying a geographically significant component of the domain name (col. 4, line 56-col. 5, line 7); determining a geographic location for the domain name based at least in part of the geographically significant component (col. 8, lines 6-30); determining a possible geographic location of the client based on a geographically significant component of a text based network address corresponding to the client network address (col. 4, line 56-col. 5, line 7); and validating the possible geographic location of the client using the determined geographical location of the domain name identified in the trace route, the validating returning a validated geographic location of the client (col. 8, lines 13-22).

11. As to claim 2, Merriman teaches the method of claim 1, further comprising: analyzing domain names associated with a network access provider so as to identify the construction formats for said domain names (col. 8, lines 6-30); identifying geographically significant components of said construction components (col. 4, line 56-col. 5, line 7); and storing cross-references between said geographically significant components and geographic locations in a storage (col. 8, lines 6-30).

Art Unit: 2142

12. As to claim 3, Merriman teaches the method of claim 1, further comprising: performing a first geographic location determination for the network address based on determined geographical location for the domain name returned in the traceroute (col. 8, lines 6-30); performing at least one alternate geographical determination for the network address based on at least one additional determined geographic location for at least one additional domain name returned from the trace route (col. 8, lines 6-30); and selecting a validated geographic location of the client from either the first geographic location determination or one of the at least one additional determined geographic location determinations (col. 8, lines 6-30).

13. As to claim 4, Merriman teaches the method of claim 3, further comprising: ranking said determined geographic locations in accordance with the number of alternate geographic location determinations consistent with said determined geographic locations (col. 8, lines 15-22).

14. As to claim 6, Merriman teaches the method of claim 1, wherein said performing the trace route is performed from the server to the client (col. 8, lines 6-30).

15. As to claim 7, Merriman teaches the method of claim 1, wherein said performing the trace route is performed from the client to the server (col. 8, lines 6-30, interpreting the machine that initiates the traceroute as the client and the user's ISP as the server. Notice applicant's specification merely states that a client can perform a traceroute to the server at page 5, lines 9-10 but never describes anything else about such a limitation so therefore claim 7 is interpreted broadly).

16. As to claim 8, Merriman teaches the method for determining a geographic location for a network address, comprising: receiving a trace route comprising first and second network host identifiers for hosts disposed between a server and a client on a network (col. 8, lines 6-30);

Art Unit: 2142

matching the first network host identifier to a first template (col. 4, line 56-col. 5, line 7); first parsing the first network host identifier according to the first template to determine a first geographically significant component (col. 4, line 56-col. 5, line 7); and identifying an estimated geographic location for the client based at least in part on said first parsing (col. 8, lines 6-30); matching the second network host identifier to a second template to determine a first geographically significant component (col. 8, lines 23-30, first template is the country code in col. 5, lines 1-7); second parsing the second network host identifier according to the second template determine a second geographically significant component (col. 8, lines 6-30 and second template is the ISP check); and revising said estimated geographic location based at least in part on said second parsing (col. 8, lines 6-30, the traceroute is done to obtain multiple addresses).

17. As to claim 10, Merriman teaches the method of claim 8, further comprising: revising said estimated geographic location based at least in part on a client profile associated with the client (col. 7, lines 15-31).

18. As to claim 11, Merriman teaches the method of claim 10, further comprising: said client contacting the server with the web browser, said browser providing the client profile to the server (col. 7, lines 15-31).

19. As to claim 12, Merriman teaches the method of claim 10, wherein the client profile is based at least in part on a customer database identifying the client (col. 5, lines 50-63).

20. As to claim 13, Merriman teaches the method of claim 10, wherein the client profile is based at least in part on a mass-marketing database identifying the client (col. 5, lines 50-63).

21. As to claims 18-21 and 23-30, they feature the same limitations as claims 1-4 and 6-13, respectively, and are thus rejected for the same reasons as 1-4 and 6-13.

Art Unit: 2142

22. As to claims 35-37, they are rejected for the same reasons as claims 1-3.
23. As to claims 38-39, they are rejected for the same reasons as claims 8-9.
24. As to claim 40, Merriman teaches the apparatus of claim 38, further comprising: revising means for revising said estimated geographic location based at least in part on a client profile associated with the client (col. 5, lines 50-63).
25. As to claims 44, Merriman teaches the method of claim 1, wherein identifying a geographically significant component of the domain name and network address comprises: performing one of lexical analysis or pattern matching on the domain name and the text based network address to match against known formats (the domain parsing is pattern matching and the type matching is lexical); and selecting a likely geographically significant component using a deductive algorithm to analyze the domain name and text based network address (col. 8, lines 6-30 is considered a deductive algorithm. Such a term is not described in the applicant's specification so it is interpreted broadly).
26. As to claim 45, Merriman teaches the method as recited in claim 44, wherein the deductive algorithm comprises one of an expert system or rule based system (col. 8, lines 6-30, ISP list is an expert system and col. 5, lines 1-7 is a rule based system).
27. As to claims 46-49, they are rejected for the same reasons as claims 44-45.
28. Claims 1-7, 14-16, 18-24, 31-33, 35-37, 41-45 and 50 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Number 6,826,617 to Ansell et al.
29. As to claim 1, Ansell teaches a method for geographic location determination based at least in part on inspection of a network address of a client, the method comprising: performing a trace route between a server and the address of the client (col. 10, lines 20-49); the trace route

Art Unit: 2142

identifying at least one domain name in a route between the server and the client identifying a construction format for the domain name (col. 10, lines 20-49); identifying a geographically significant component of the domain name (col. 10, lines 20-49); determining a geographic location for the domain name based at least in part of the geographically significant component (col. 10, lines 20-49); determining a possible geographic location of the client based on a geographically significant component of a text based network address corresponding to the client network address (col. 9, lines 26-43); and validating the possible geographic location of the client using the determined geographical location of the domain name identified in the trace route, the validating returning a validated geographic location of the client (Figure 4).

30. As to claim 2, Ansell teaches the method of claim 1, further comprising: analyzing domain names associated with a network access provider so as to identify the construction formats for said domain names (col. 14, lines 1-67); identifying geographically significant components of said construction components (col. 14, lines 1-67); and storing cross-references between said geographically significant components and geographic locations in a storage (col. 14, lines 1-67).

31. As to claim 3, Ansell teaches the method of claim 1, further comprising: performing a first geographic location determination for the network address based on determined geographical location for the domain name returned in the traceroute (col. 14, lines 1-67); performing at least one alternate geographical determination for the network address based on at least one additional determined geographic location for at least one additional domain name returned from the trace route (col. 14, lines 1-67); and selecting a validated geographic location

of the client from either the first geographic location determination or one of the at least one additional determined geographic location determinations (col. 14, lines 1-67).

32. As to claim 4, Ansell teaches the method of claim 3, further comprising: ranking said determined geographic locations in accordance with the number of alternate geographic location determinations consistent with said determined geographic locations (col. 14, lines 1-67).

33. As to claim 5, Ansell teaches the method of claim 1, further comprising: providing a regular expression corresponding to the construction format (col. 14, line 41); matching the regular expression against the domain name (col. 14, lines 1-67); and identifying a geographically significant portion of the regular expression so as to facilitate said identifying the geographically significant component of the domain name (col. 14, lines 1-67).

34. As to claim 6, Ansell teaches the method of claim 1, wherein said performing the trace route is performed from the server to the client (col. 10, lines 20-49).

35. As to claim 7, Ansell teaches the method of claim 1, wherein said performing the trace route is performed from the client to the server (col. 10, lines 20-49, interpreting the machine that initiates the traceroute as the client and the user's ISP as the server. Notice applicant's specification merely states that a client can perform a traceroute to the server at page 5, lines 9-10 but never describes anything else about such a limitation so therefore claim 7 is interpreted broadly).

36. As to claim 14, Ansell teaches a method of determining a geographic location, comprising: creating a log comprising network addresses of clients that have communicated with a web server (col. 5, lines 48-59, the TR server keeps a log of inquiries about client location); filtering the log so as to remove undesirable network addresses (col. 10, lines 20-49, the

Art Unit: 2142

traceroute is only done for addresses that are not known); asynchronously performing a trace route between a first one of said filtered network addresses and the server regardless of whether a previous geographic location for the first one of said filtered network addresses had been determined (col. 10, lines 20-49); analyzing a result of said asynchronous performed trace route to ascertain a geographically significant component of at least one network address between a first one of said filtered network addresses and the server (col. 10, lines 20-49); and determining a geographic location for said first one responsive to said analyzing (col. 10, lines 20-49).

37. As to claim 15, Ansell teaches the method of claim 14, further comprising: generating a report comprising geographic locations for clients that have communicated with the web server (col. 5, lines 48-59).

38. As to claim 16, Ansell teaches the method of claim 14, wherein said determining the geographic location comprises: matching the result against a template identifying geographically significant portions of network addresses formatted in compliance with the template (col. 14, lines 1-67).

39. As to claims 18-24 and 31-34, they feature the same limitations as claims 1-7 and 14-17, respectively, and are thus rejected for the same reasons as claims 1-7 and 14-17.

40. As to claims 35-37, they are rejected for the same reasons as claims 1-3.

41. As to claims 41-43, they are rejected for the same reasons as claims 14-16.

42. As to claims 44, Ansell teaches the method of claim 1, wherein identifying a geographically significant component of the domain name and network address comprises: performing one of lexical analysis or pattern matching on the domain name and the text based network address to match against known formats (col. 10, lines 20-49); and selecting a likely

Art Unit: 2142

geographically significant component using a deductive algorithm to analyze the domain name and text based network address (col. 10, lines 20-49).

43. As to claim 45, Ansell teaches the method as recited in claim 44, wherein the deductive algorithm comprises one of an expert system or rule based system (col. 10, lines 20-49).

44. As to claim 50, Ansell teaches the method of claim 14, wherein analyzing a result of said asynchronous performed trace route further comprises: selecting a first and second network address in the trace route (col. 10, lines 20-49 and col. 14, lines 1-67); performing a reverse address lookup of the first and second network address and the first one of said filtered network addresses, the first one of said filtered network addresses corresponding to a client, the performing to derive a first and second text based network address and client text based network address (col. 10, lines 20-49 and col. 14, lines 1-67); performing one of lexical analysis or pattern matching on the first and second text based network address and the client text based network address to match against known formats; and selecting a likely geographically significant component for each text based network address using a deductive algorithm to analyze the text based addresses (col. 10, lines 20-49 and col. 14, lines 1-67); and returning the likely geographically significant components for use in the determining a geographic location for the client (col. 10, lines 20-49 and col. 14, lines 1-67). None of these limitations are described in a limiting manner so therefore the cited portion of Ansell reads on these limitations as broadly interpreted.

Conclusion

45. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

46. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Douglas B. Blair whose telephone number is (571) 272-3893. The examiner can normally be reached on 9:00am-5:30pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Caldwell can be reached on (571) 272-3868. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2142

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Douglas Blair

DBB



ANDREW CALDWELL
SUPERVISORY PATENT EXAMINER